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In re application of Edward B. Goldberg :  
Serial No. : 10/009,874 : DECISION ON PETITION  
Filed : December 11, 2001 :  
Attorney Docket No.: NANF.P-007 :

This is in response to applicants' petition, filed January 12, 2004 under 37 CFR 1.144, to withdraw the restriction requirement set forth by the examiner.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 as the National Stage of PCT/US99/13024, filed June 11, 1999. The application, as filed with preliminary amendments, contained claims 1-4 and 7-47. In a first Office action mailed August 8, 2003, the examiner set forth a restriction / lack of unity requirement under 35 U.S.C. 121 and 372 dividing the claims into 2 groups. On September 5, 2003 applicant filed a response in which the restriction requirement was traversed on essentially the same grounds argued in the petition. On December 18, 2003 the examiner mailed an Office action (non-final rejection) in which the restriction requirement was made final.

DISCUSSION

Applicant argues that all of the claims have unity of invention because the claims are drawn to protein and DNA encoding the protein, citing Example 17 of Annex B of the PCT Administrative Instructions. This argument is not persuasive because the claims are not analogous to those presented in the example. The claims in the example are limited to a single protein and the DNA encoding it. The claims in the instant application are drawn to a gp35 protein, variants of the protein having deletion or substitution mutations, fragments of the protein having certain functional characteristics, and proteins having as little as 30% identity to a fragment of the gp35 protein. Nucleic acid claims are drawn to nucleic acids encoding gp35, nucleic acids encoding fragments and mutated forms of gp35, and encoding proteins only 30% similar to a fragment of gp35, as well as PCR primers which bind outside the protein coding sequence. Thus there is not a one-to-one correspondence between the claimed proteins and nucleic acids, nor do all of the proteins (or all of the nucleic acids) share a common core structure. Therefore the claims lack unity of invention within the meaning of PCT Rule 13.2.

DECISION

Applicant's petition is **DENIED**.

The time period for response continues to run from the date of mailing of the previous Office action, December 18, 2003.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA, 22313-1450, or by telephone at (571) 272-0974 or by facsimile transmission at (571) 273-0974.

John Doll



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